

### REMARKS

As a preliminary matter, Applicant thanks the Examiner and his supervisor, Examiner George Evanisko, for the time and courtesy extended to Applicant's representatives during the personal interview of August 17, 2006 in which the Final Office Action was discussed. In the Final Office Action,<sup>1</sup> the Examiner took the following actions:

- (a) objected to the drawings under 37 C.F.R. § 1.83(a);
- (b) objected to the specification for informalities;
- (c) rejected claims 24-45 and 48-54 under 35 U.S.C. § 112, second paragraph, as being indefinite;
- (d) rejected claims 23 and 45 under 35 U.S.C. § 101;
- (e) rejected claims 1, 2, 4-12, 18-26, 29-32, 35, 41, 42, and 44 under 35 U.S.C. § 102(b) as being anticipated by Cohen (U.S. Patent No. 5,174,289) ("Cohen");
- (f) rejected claim 3 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Cohen;
- (g) rejected claims 27, 33, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Cohen in view of Helland (U.S. Patent No. 5,385,579) ("Helland");
- (h) rejected claims 13, 14, 17, 36, 37, and 40 under 35 U.S.C. § 103(a) as being unpatentable over Cohen in view of Prystowsky et al. (U.S. Patent No. 4,554,922) ("Prystowsky");
- (i) rejected claims 15 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Cohen in view of Prystowsky and further in view of Altman (U.S. Patent No. 5,551,427) ("Altman");
- (j) rejected claim 28 under 35 U.S.C. § 103(a) as being unpatentable over Cohen in view of Smits (U.S. Patent No. 4,641,656) ("Smits");
- (k) rejected claims 34, 38, 39, 45-47, 51, and 52 under 35 U.S.C. § 103(a) as being unpatentable over Cohen in view of Smits and further in view of Altman; and

---

<sup>1</sup> The Office Action contains statements characterizing certain references, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicant declines to automatically subscribe to any statements in the Office Action.

- (l) rejected claims 48-50, 53, and 54 under 35 U.S.C. § 103(a) as being unpatentable over Cohen in view of Smits, Altman, and Prystowsky.

In this response, Applicant has cancelled claims 13-17, 36, 37, 48-50, and 54, and amended claims 1, 18, 19, 23, 24, 29-31, 33-35, 41, 45, 46, and 51, without prejudice or disclaimer. As a result, the rejections with respect to claims 13-17, 36, 37, 48-50, and 54 are now moot. In addition, Applicant has added new claims 55-64. Applicant has also amended the Abstract and Specification, as indicated hereinabove.

**Objection to the Drawings:**

In the Office Action, the drawings were objected to because they “fail to show element 140 in Figure 1 as described in the specification and noted in the figure.” Final Office Action, p. 2. During the interview, the Examiner agreed to Applicant’s proposal to amend Fig. 1 to remove reference to lead 130 and second right ventricle electrode 140 illustrated near the bottom of the drawing, and to amend par. [028] of the specification. See Interview Summary. In response to the objection, Applicant has so amended Fig. 1 and attached amended Fig. 1, labeled “Replacement Sheet.” In addition, Applicant has amended par. [028] of the specification to indicate that the second right ventricle electrode is not shown in the figure. Accordingly, Applicant deems the objection overcome and respectfully requests its withdrawal.

**Objection to the Specification:**

In the Office Action, the disclosure was objected to and it was recommended that “‘the’ should be inserted between ‘of’ and ‘heart’ in paragraph 060.” Final Office Action, p. 3. In accordance with the suggestion in the Office Action, Applicant has amended par. [060] to insert “the” between “of” and “heart.” Applicant therefore deems the objection overcome and respectfully requests its withdrawal.

**Rejection of Claims 24-35, 38-45 and 51-53 under 35 U.S.C. § 112, Second ¶:**

The Examiner rejected claims 24-35, 38-45, and 51-53 under 35 U.S.C. § 112, second paragraph, “as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” Final Office Action, p. 3. In particular, the Examiner alleged that “[i]t is unclear whether applicant is claiming electrodes placed in the ventricle, on the ventricle, or both.” Id.

During the interview, the Examiner suggested amendments to the claims to overcome this rejection. Specifically, the Examiner suggested amending the rejected claims so that they include “in or around” language and noted that such an amendment would not only overcome the rejection, it would broaden the scope of the claims. See Interview Summary. Although Applicant does not agree with the Examiner’s rejection and believes that the claims are definite, Applicant has amended claims 24, 29-31, 33-35, 41, and 51 to recite “in or around the left ventricle,” as suggested by the Examiner, to expedite prosecution of this application. Applicant therefore deems the rejection overcome and respectfully requests its withdrawal.

**Rejection of Claims 23 and 45 under 35 U.S.C. § 101:**

In the Office Action, claims 23 and 45 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, according to the Examiner, because “[t]hese claims comprise electrodes implanted in the heart,” they comprise “a portion of the human anatomy, which is non-statutory subject matter.” Final Office Action, p. 4.

During the interview, the Examiner proposed inserting language such as “implantable,” or “adapted to be implanted” in claims 23 and 45 to overcome this rejection. See Interview Summary. Although Applicant does not agree with the Examiner’s rejection and believes that the claims are directed to statutory subject matter, Applicant has amended claims 23 and 45 to

recite “adapted to be implanted,” as suggested by the Examiner, to expedite prosecution of this application. Applicant therefore deems the rejection overcome and respectfully requests its withdrawal.

**Rejection of Claims 1, 2, 4-12, 18-26, 29-32, 35, 41, 42, and 44 under 35 U.S.C. § 102(b) over Cohen:**

In the Office Action, claims 1, 2, 4-12, 18-26, 29-32, 35, 41, 42, and 44 were rejected under 35 U.S.C. § 102(b) as being anticipated by Cohen. Applicants respectfully traverse this rejection because Cohen does not disclose the combination of features recited in these claims.

During the interview, the Examiner indicated that using language such as “spatial progress” or “suffering from heart failure” would likely overcome this rejection over Cohen. See Interview Summary. Although Applicant does not agree with the Examiner’s rejection and believes that the claims are allowable over Cohen, Applicant has amended claims 1, 18, 19, 24, and 41 to recite “suffering from heart failure” and “for treatment of heart failure,” as discussed with the Examiner, to expedite prosecution of this application.

As explained to the Examiner during the interview, Cohen is not directed to treatment of heart failure. Moreover, Cohen does not disclose all of the features recited in the rejected claims.

Independent claims 1, 18, 19, 24, and 41 are therefore allowable, as are claims 2, 4-12, 20-23, 25-32, 35, 42, and 44, at least due to their respective dependence from the allowable base claims. Applicant thus deems the rejection overcome and respectfully requests its withdrawal.

**Remaining Rejections of Claims 3, 27, 28, 33, 34, 38-40, 43, 45-47, and 51-53 under 35 U.S.C. § 103(a) over one or more of Cohen, Prystowsky, Smits, Altman, and/or Helland:**

Claims 3, 27, 28, 33, 34, 38-40, 43, 45-47, and 51-53 were rejected under 35 U.S.C. § 103(a) over one or more of Cohen, Prystowsky, Smits, Altman, and/or Helland. Applicant traverses these rejections and requests reconsideration and withdrawal of these rejections.

Applicant respectfully disagrees with the Examiner's arguments and conclusions. A *prima facie* case of obviousness has not been established. As M.P.E.P. § 2142 states, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness."

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006), p. 2100-125, 126.

Each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143. A requirement for establishing a *prima facie* case of obviousness is not met, at least because Cohen, taken alone or in combination with the secondary and tertiary references, does not teach or suggest every feature of Applicant's claims.

In response to these rejections, Applicants rely on the reasoning presented in the previous section. As discussed, independent claims 1, 18, 19, 24, and 41 are not anticipated by Cohen. Independent claims 46 and 51 recite features similar to those in claims 1, 18, 19, 24, and 41, and are also not anticipated by Cohen at least for the same reasons stated above with respect to claims 1, 18, 19, 24, and 41. Accordingly, these claims are also not obvious over Cohen.

The secondary and tertiary references, taken alone or in combination with Cohen, do not combine to teach each and every element of the rejected claims. For example, Prystowsky is directed to defibrillation for controlling arrhythmia and is not directed to the treatment of heart failure. In addition, Smits is directed to defibrillation and not to pacing for treatment of heart

failure; Altman is directed to drug delivery and not electrical stimulation; and Helland is directed to a mechanical anchoring of a lead, and not to stimulation of a heart.

Claims 3, 27, 28, 33, 34, 38-40, 43, 45-47, and 51-53 are therefore not obvious over the cited references, and are allowable for the reasons presented. Applicant deems the rejections overcome and respectfully requests their withdrawal.

**Regarding New Claims:**

Applicant has added new claims 55-64 and submits that these new claims 55-64 are supported by the original disclosure as-filed. In addition, Applicant submits that these new claims are allowable at least because none of the cited references, taken alone or in combination, teaches or suggests each and every element of claims 55-64.

**Conclusion:**

In view of the foregoing, Applicant requests reconsideration of the application and withdrawal of the rejections. Pending claims 1-12, 18-35, 38-47, 51-53, and 55-64 are in condition for allowance, and Applicant requests a favorable action.

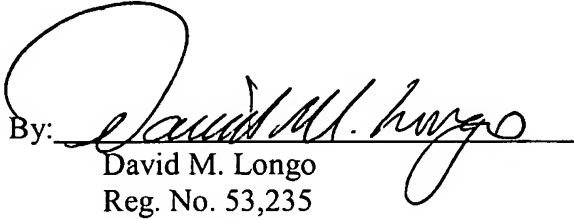
If there are any remaining issues or misunderstandings, Applicant requests the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: November 30, 2006

By:   
David M. Longo  
Reg. No. 53,235

/direct telephone: (202) 408-4489/